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PATENT OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 47

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM P. APPS
and ARNE LANG-REE

Appeal No. 94-3612
Application 07/944,742¹

HEARD:
June 9, 1995

Before COHEN, LYDDANE, and STAAB, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed October 21, 1992, which is, according to appellants, a continuation-in-part of Serial No. 07/272,039, filed November 15, 1988, now U.S. Patent No. 4,932,532, granted June 12, 1990; and a continuation-in-part of Serial No. 07/369,598, filed June 21, 1989, abandoned; and a continuation-in-part of Serial No. 07/357,068, filed May 23, 1989, now U.S. Patent No. Des. 317,670, granted January 1, 1991.

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This appeal is from the final rejection of claims 75, 76, and 78 through 83, all the claims remaining in the application.

Appellants' invention pertains to a tray for cylindrical containers, such as beer or soda cans, adapted to be nested with other trays when empty of the containers and stacked with other trays when loaded with the containers. As explained on pages 6-7 of the specification:

[T]he bottom of the tray floor is molded with a pattern of redoubt members or downward protuberances to help locate an upper tray on a loaded lower tray beneath it. These protuberances are positioned so to define recessed areas between them up into which the rims of the layer of cans beneath it fit. . . . [W]ith the top tray located on a layer of cans beneath it the can rims are positioned in the recessed areas and the trays are in a locked position. The protuberances have their perimeter edges bevelled. Thus, with the trays in the locked position the top tray can be twisted a slight angle, the protuberances ride up their bevelled edges on the rims to an unlocked position and the loaded top tray slid freely on and along the rimmed cans beneath it.

Claim 75, the sole independent claim on appeal, is further illustrative of the subject matter at issue and a copy thereof, as it appears in the appendix to appellants' brief, is appended to this opinion.

The references of record relied upon by the examiner in support of a rejection under 35 U.S.C. § 103 are:

Delbrouck et al. (Delbrouck)	3,791,549	Feb. 12, 1974
Bridges et al. (Bridges)	3,949,876	Apr. 13, 1976

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Claims 75, 76, and 78 through 83 stand rejected under 35 U.S.C. § 103 as being unpatentable over Delbrouck in view of Bridges. According to the examiner:

It would have been obvious to one of ordinary skill in the art to have employed the downward projection teaching of Bridges, et. al. in the construction of the device of Delbrouck, et. al., replacing the bottle stacking projections, sized appropriately for cans, i.e. low depth. The employment of downwardly projecting ring structure in the construction of the above set forth device would have been an obvious substitution of equivalents and motivated by the savings in material. . . . The reference to Bridges, et. al. teaches the employment of downward projections that allow for stacking of multiple trays, with the projections located within the rim of containers and outer rim surrounding surfaces carried by the tray, note fig.7 [sic] and col. 1, lines 42+. One of ordinary skill, with access to the teachings of Bridges, et. al., would have realized the pertinence to beverage can structure. The employment of flat floor top surfaces in the construction of beverage can tray structure is widely accepted in the field, as evidenced by the prior art of record, official notice is taken of such. The employment of such structure in the construction of the above set forth device would have been obvious to one of ordinary skill in the art, producing no new and unobvious results, motivated by the ease of loading the tray. [Answer, page 3-4]

Appellants do not dispute the examiner's position that it is known in the art to construct beverage can trays with a flat floor top surface. Appellants argue, however, that (1) the references do not provide the motivation to one of ordinary skill in the art to combine their features in the manner proposed by the examiner, (2) the examiner has improperly modified the secondary reference in arriving at the claimed invention, and

(3) even if properly combined, the applied references relied upon by the examiner do not meet the limitations of the claimed invention.

OPINION

Our consideration of the obviousness issues presented in this appeal begins with a consideration of Delbrouck, the primary reference. Delbrouck pertains to a nestable and stackable crate for storing and transporting disposable plastic container, such as yogurt containers. According to Delbrouck, there is a need when packaging and transporting such containers to provide for adequate ventilation. To this end, the center portion of the support surface for each of the individual containers is provided with an aperture 20 to permit ventilation of the container and the crate. Column 2, lines 23-25; column 2, lines 40-44; column 3, lines 49-50. The floor of Delbrouck's crate comprises a series of strips, certain ones of which are bent upwardly at an angle, as at elements 18, to provide lateral support for individual containers to be carried therein. In addition, the bottom surface of the crate of Delbrouck is provided with circular recesses 19 so that when loaded crates are stacked, the upper edges of containers in the lower crate are disposed in the recesses provided in the bottom surface of the upper crate whereby "[l]ateral movement of the crates is . . . prevented"

(column 1, lines 60-61) and "[t]he crates are . . . interlocked and cannot be laterally displaced" (column 3, lines 46-47).

Bridges pertains to thermally insulated trays. An objective of Bridges is to provide "a novel beverage serving system wherein individual portions of a beverage may be prepared a considerable time before they are intended to be served and held at a desired serving temperature until individual service is called for" (column 1, lines 37-41). In furtherance of this objective, a tray is provided with depressions 8 on its upper surface for receiving the bottoms of insulated tumblers or mugs 10 and annular recesses 12 on its lower surface for mating with the upper edges of tumblers or mugs of a loaded tray. Further,

each bottom recess 12 is formed so as to have a downwardly projecting portion 24 surrounded by a groove 26. Thus when a number of containers and trays are assembled as shown in FIG. 7 the upper edge 28 of each container 10 engages in a groove 26 with the portion 24 extending slightly into the open end of the container whereby an effective thermal seal is provided. [Column 2, line 68 through column 3, line 7]

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 USC §103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings

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to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

It is apparent to us that the combined teachings of the applied references do not suggest the claimed subject matter. As aptly pointed out by appellants, Delbrouck, because of the particular needs of the containers intended to be stored and transported, specifically provides ventilation apertures 20 in the center portion of the support surface for the individual containers. On the other hand, Bridges provides grooves 26 and projecting portions 24 which closely conform to the upper edges of the containers to provide a thermal seal. One of ordinary skill in the art, in keeping with the teachings of Delbrouck, would have found it highly undesirable to provide therein thermal seals of the type disclosed by Bridges, for to do so would foil Delbrouck's ventilation purpose. The examiner has not explained, nor is it apparent to us, how these two conflicting purposes can be reconciled. In the absence of some sound reason why the ordinarily skilled artisan would have found it desirable to

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incorporate the arrangement of Bridges in Delbrouck, the rejection cannot stand.

As for the examiner's statement that the proposed modification would have been "an obvious substitution of equivalents" (answer, page 4), we would point out that, even if the recesses 19 of Delbrouck and the grooves 26 of Bridges could somehow be regarded as "equivalents," the mere existence of functional and mechanical equivalents does not establish obviousness. See *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966) and *In re Scott*, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963). Moreover, the examiner's theory that the proposed modification "would have been . . . motivated by the savings in material" (answer, page 4) is not persuasive in the absence of some explanation as to why the ordinarily skilled artisan would have disregarded the clear teachings of Delbrouck regarding the provision of apertures 20 to promote ventilation. Furthermore, it would appear that providing the bottom surface of Delbrouck with grooves and downwardly projecting portions such as shown at elements 26, 24 of Bridges would result in a net increase in the amount of material used. In addition, it is noted that independent claim 75 calls for the downward projections "providing rotatably releasable engagement . . . with the top rims of the containers loaded in said tray therebeneath." In that the recesses 19 of Delbrouck engage the upper edges of the

containers such that "[t]he crates . . . are interlocked and cannot be laterally displaced" (column 3, line 46-47) and in that the grooves 26 of Bridges establish a thermal seal with the rims of the containers 10, it is questionable whether downward projections of the modified Delbrouck crate would be capable of the type of engagement called for in the claims. Finally, the examiner has provided no cogent reason why one of ordinary skill in the art would have eliminated the holding strips 18, which strips stabilize the containers and aid in preventing stacked loaded trays from being laterally disposed. In light of the foregoing, the rejection of claims 75, 76, and 78 through 83 as being unpatentable over Delbrouck in view of Bridges cannot be sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

WILLIAM E. LYDDANE
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

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APPENDIX

75. A low depth tray for cylindrical containers adapted to be nested with other trays when empty of the containers and stacked with other trays when loaded with the containers, said tray comprising:

a low depth side wall structure comprising a band extending around the periphery of said tray for preventing the cylindrical containers from tipping during transport;

a floor structure connected to said wall structure, said floor structure comprising

a substantially flat, open floor top surface having a plurality of support areas for supporting the containers thereon, and

a floor bottom surface having a plurality of spaced downward projections adapted to prevent free sliding of said tray when loaded with the containers and stacked with other trays, the containers each having a top surface defining top rims of the containers, wherein said projections are positioned to be within the top rims of containers in an adjacent tray beneath said tray when loaded with containers and stacked, and also positioned to surround the top rims of containers in an adjacent tray beneath said tray when loaded with containers and stacked, thereby providing rotatably releasable engagement of the bottom of an adjacent tray with the top rims of containers loaded in said tray therebeneath; and

a plurality of columns interconnecting said band and said floor structure, said columns configured to nest deeply with columns of another empty tray.